



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,069	09/07/1999	ELIZABETH F. CHURCHILL	FXPL-01000US	8020

23910 7590 11/12/2003

FLIESLER DUBB MEYER & LOVEJOY, LLP
FOUR EMBARCADERO CENTER
SUITE 400
SAN FRANCISCO, CA 94111

EXAMINER

NAJJAR, SALEH

ART UNIT	PAPER NUMBER
----------	--------------

2157

//

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/391,069

Applicant(s)

CHURCHILL ET AL.

Examiner

Saleh Najjar

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-20, 22-25 and 27-47 is/are rejected.
- 7) ☒ Claim(s) 9, 21, 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 2157

1. This action is responsive to the communication filed on August 29, 2003. Claims 1-47 are pending examination. Claims 1-47 represent an apparatus and method for anchored conversations adhesive in content supporting virtual discussion forums.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-10, 15-20, 22-25, 27-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkado, U.S. Patent No. 6,542,165.

Ohkado teaches the invention substantially as claimed including a system and method for relating annotation data to an application window (see abstract).

As to claim 1, Ohkado teaches a system for placing and maintaining anchored conversations within an artifact, comprising:

an application configured to access the artifact (see figs. 1-3; col. 9, line 16, Ohkado discloses a subject application for accessing a file).

A transparent window (message box) configured to access said anchored conversation and to receive communications regarding a portion of the artifact (see fig. 3; col. 9, lines 48-62, Ohkado discloses a transparent window displayed on top of the application file window including a receive and transmission control parts 233, 235 which receives and transmits change data from drawing control part 209);

An anchor configured to identify a location within said artifact with which said (message box / transparent window) is associated (see figs. 2-3; col. 11, lines 5-12, Ohkado discloses a display control part 225 that specifies the position and size of the transparent window);

Art Unit: 2157

a conversation coordinator configured to maintain a relationship between the anchor, the conversation client and the anchored conversation (see figs. 1-3; col. 10, Ohkado discloses a an annotation control window that coordinates the conversation within the message box / transparent window).

Ohkado fails to teach the limitation of a conversation client. Ohkado does teach that the transparent window relates conversations between computers regarding a commonly viewed application and file using program code parts 233, 235, 207, that transmit and receive data entered by clients in the message box/ transparent window (see col. 9-11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ohkado by specifying the program code parts 233, 235, 207, and the transparent window as a conversation client since the same functionality of transmitting messages confined to a commonly viewed message box is achieved.

As to claim 2, Ohkado teaches the system according to claim 1.

Ohkado fails to teach the limitation wherein said conversation coordinator and said conversation client (transparent window / message box) are separate applications. Ohkado does teach that the different program codes for implementing the subject application 201, transparent window 205, window procedure 207, drawing part 209, drawing control part 211, hook 213, receive/transmit control parts 233, 235 are not necessarily all implemented on the client machine and are shown in the figure as separate blocks in the drawing diagram and that the server machine may implement some functions of the code parts present at the client (see col. 8, line 60- col. 9, line 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ohkado by configuring the conversation client (transparent window 205) and conversation coordinator (annotation control) as two separate applications. One would be motivated to do so since Ohkado does suggest that some of the program codes implemented on the client can reside separately on a server.

As to claim 3, Ohkado teaches the system according to claim 1, wherein said communications received by said conversation client (transparent window 205) are persistent and accessible via said conversation coordinator (see figs. 2-3; col. 9-12).

As to claim 5, Ohkado teaches the system according to claim 1, wherein: said conversation coordinator comprises, a request handler configured to receive conversation requests from a requesting conversation client, and a client mechanism configured to initiate a recipient conversation client having an anchor position, application, and artifact equivalent to the application, artifact, and anchor position of the requesting conversation client (see figs. 1-5; col. 9-13).

As to claim 6, Ohkado teaches the system according to claim 5, wherein said request handler includes an approval mechanism that identifies whether an intended recipient of the conversation request approves entering into an anchored conversation (see col. 12, lines 35-40).

As to claim 7, Ohkado teaches the system according to claim 6.

Ohkado fails to teach the limitation wherein said approval mechanism includes an id device that identifies all participants of a conversation to the intended recipient.

However, "Official Notice" is taken that the concept and advantages of implementing a conversation approval mechanism configured to identify the participants of a conversation to the recipient is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ohkado by implementing conversation approval mechanism configured to identify the participants of a conversation to the recipient. One would be motivated to do so to prevent unauthorized participation in a conversation.

As to claim 8, Ohkado teaches the system according to claim 5, wherein:

said client mechanism comprises, a startup mechanism configured to initiate a target application associated with a conversation request received by the request handler; a retrieval mechanism configured to retrieve an artifact associated with the conversation request and load the retrieval artifact into the target application; a connection manager configured to establish a communications link with the requesting conversation client and the recipient conversation client; and an anchor device configured to locate and attach the recipient conversation client to the equivalent anchor position in the retrieved artifact (see col. 10-12).

As to claim 9, Ohkado teaches the system according to claim 8, wherein said

Art Unit: 2157

anchor device is further configured to track a location of said equivalent anchor position, and position a user interface of the conversation client to within a predetermined proximity of the anchor if a position of the anchor is moved (see col. 11, lines 5-15).

As to claim 10, Ohkado teaches the system according to claim 8, wherein said anchor device comprises:

an attachment device configured to maintain a position of the conversation client relative to the corresponding anchor; an unattach device configured to disassociate the position of the conversation client from a corresponding anchor; and reattachment device configured to re-attach a detached conversation client to the position of its corresponding anchor (see figs. 11-5; col. 10, lines 5-60, Ohkado discloses modules that implement the attachment of the transparent window 205 based on user interface input).

As to claims 15-16, Ohkado teaches the system according to claim 1, further comprising:

an interface mechanism configured to initiate at least one target application and load an artifact into the target application; and an anchor device configured to anchor a conversation client to one of the artifact and an anchor of the artifact, wherein said interface mechanism includes at least one application control device configured to direct operations of at least one target application via a target interface. (see col. 8-12, Ohkado discloses that program code modules/parts are used to relay events generated on the transparent screen of the shared application window using Graphical user interface modules and hook).

Ohkado fails to teach the claimed limitation of an API for directing control of a target application. Ohkado discloses that the system is implemented using a multitasking operating system and that the transparent window is operated by the operating system and subapplication interface and that the system can be implemented using independent, complex or shared hardware / software (see col. 8-9; col. 9, lines 60-67).

"Official Notice" is taken that the concept and advantages of implementing API mechanisms to control target applications is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ohkado by implementing independent applications for performing the function of the transparent window and the shared application. One would be motivated to do so to provide the capability for a shared application program to access operating system and other services and provide a level of abstraction between the application and the kernel (or other privileged utilities) to ensure the portability of the code.

As to claims 17-20, Ohkado teaches the system according to claim 5.

Ohkado fails to teach the limitation, wherein said conversation coordinator further comprises a synchronization device configured to notify a user of the recipient conversation client if the artifact associated with the recipient conversation client becomes out of sync with a master document, wherein said synchronization device includes an activatable input mechanism by which a user may activate a synchronization process to update the out of synch artifact.

However, "Official Notice" is taken that the concept and advantages of synchronizing a document with a master document in a shared application environment is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ohkado by implementing a synchronization mechanism to synchronize shared documents.

Claims 22-25 and 27 do not teach or define any new limitations above claims 1-3, 5-10, 15-20 and therefore are rejected for similar reasons.

Claims 28-32 are rejected for similar reasons as claims 1-3, 5-10, 15-20.

Ohkado fails to teach the claimed limitation wherein said anchor comprises an ActiveX component.

However, "Official Notice" is taken that the concept and advantages of using Active X components within shred software is old and well known in the art.

Art Unit: 2157

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ohkado by implementing the transparent window and window position using Active X components. One would be motivated to do so to allow communication between clients over slow Internet links.

Claims 33-47 are rejected for similar reasons as claims 1-3, 5-10, 15-20.

The claimed limitation of changing context information associated with conversation window / client is taught by Ohkado since Ohkado teaches that the shape of the pointer can be changed including fonts between applications (see col. 9-12).

4. Claims 4, and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkado, U.S. Patent No. 6,542,165 in view of England, U.S. Patent No. 6,144,991.

Ohkado teaches the invention substantially as claimed including a system and method for relating annotation data to an application window (see abstract).

As to claims 4, and 11-14, Ohkado teaches the system according to claim 1.

Ohkado fails to teach the limitation of a database configured to store conversations engaged in by said conversation client; wherein said conversation coordinator is further configured to allow a user access to any current or previous conversations stored in said database, a conversation retrieval mechanism configured to retrieve previous communications from the database that are associated with the requesting conversation client and load the retrieved previous communications into at least the recipient conversation client system.

However, England teaches a system for managing interactions between users in a network teaches of passively recording a session conversation (see col. 14; col. 20, England discloses that a session can be recorded by the director application to a file and played back later through a user request).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ohkado by implementing a database for recording and retrieving previously recorded sessions as in England since Ohkado is directed toward an application sharing system for collaboration.

5. Claims 9, 21, and 26 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Applicant's arguments filed August 29, 2003 have been fully considered but they are not persuasive.

In the remarks, the applicant argues in substance that; A) The annotations of Ohkado are not associated with artifacts (documents), but rather physical images that are transmitted; B) There is no discussion in England of anchoring a conversation client within an artifact.

In response to A); Ohkado discloses that application windows that are shared between collaborators may represent web pages which represent the broad limitation of documents (see col.2).

In response to B); England was not used as a reference to reject the claimed language of anchored conversations within an artifact. England was simply used to modify the Ohkado reference by implementing recorded conversations for later playback.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2157

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saleh Najjar whose telephone number is (703) 308-7613. The examiner can normally be reached on Monday-Friday from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Ario Etienne*, can be reached on (703) 308-7562.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600. The central official fax number for the group is (703) 872-9306.

A handwritten signature in black ink, appearing to read 'Saleh Najjar', with a stylized, cursive script.

Saleh Najjar

Primary Examiner / Art Unit 2157